

REMARKS

Claims 2-8, 10, 13-15, 17-23, 26-30, 32 and 42-51 are currently pending.

ELECTION

In the Restriction Requirement dated December 10, 2008 the Examiner imposed a Species restriction between Species I and II designated by the Examiner as follows:

- Species I: drawn to Figures 1 to 4 (two lateral wings); and
- Species II: drawn to Figure 5 (one lateral wing).

The Examiner did not restrict the claims of the invention. Applicant responded to the Examiner's restriction requirement by electing Figures 1 to 4 (and 6) directed to an embodiment of the expansion joint comprising, *inter alia*, two lateral wings. Applicant noted in the Response that all pending claims (e.g., 2-8, 10, 13-15, 17-23, 26-30, 32 and 42-51) read on the elected species. Therefore, no claims were withdrawn. See, Response to Office Action, dated January 8, 2009.

The Examiner followed up with a phone call to Applicants attorney of record stating that no election was made in the response dated January 8, 2008. Applicant's attorney, Lisa A. Chiarini, directed the Examiner to page 2 of the Response which recites "Applicant elects with traverse Species I directed to Figures 1 to 4 and contends that Figure 6 which also depicts two lateral wings also falls within Species I." In response to Applicant's attorney directing the

Examiner to the explicit election in the filed Response, the Examiner stated that none of the pending claims were withdrawn. Applicant's attorney stated that no claims were withdrawn because all of the pending claims read on the elected species. In particular, all of the claims recite (directly or indirectly), "at least one lateral wing extending from the compressible sealing portion. . ." (See independent claim 32) or "first and second lateral wings each extending from an upper portion of the compressible sealing portion" (See independent claim 45). In other words, the recitation of "at least one" of claim 32 inherently includes embodiments having one wing and embodiments having two wings, as depicted in the elected species. Further, the recitation of "first and second lateral wings" clearly on its face reads on the embodiments having two lateral wings as depicted in the elected species. The Examiner responded to Applicant's position by issuing a Notice of Non-Compliant Amendment dated March 20, 2009, in which the Examiner disagrees that "at least one lateral wing" and "first and second lateral wings" read on a species of two lateral wings. In particular, the Examiner notes that "at least one wing is not equivalent to a first and a second wing." Applicant sees no connection with the Examiner's equivalence argument and Applicant's election of two lateral wings and the claims that read on the elected species.

Because the pending claims all read on the elected species. The Notice of Non-Compliant Amendment is improper. However, despite the Examiner's error and failure to appreciate such error, Applicant desires to expedite prosecution. Thus, Applicant hereby withdraws (with traverse) independent claim 32 and claims dependent from claim 32 (e.g., 2-8, 10, 26, 27, 30, 42, 43, 50, 51). The withdrawal of these claims evidences no intent that the

withdrawn claims do not read on the elected species depicting two lateral wings of Figures 1 to 4 and 6. Accordingly, this election is not to be construed as an admission that the Species identified by the Examiner are indeed patentably distinct, nor is this election to be construed as an acquiescence to any assertions made by the Examiner.

CONCLUSION

The Examiner is invited to contact the undersigned at (212) 408-2500 if any additional information or assistance is required. Applicant believes that no additional fee is due in connection with filing of this Response. However, if any fee is required, or if any overpayment has been made, Applicant authorizes the Director to charge any fees, or credit or any overpayments made, to Deposit Account 02-4377.

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